

mouse or such pointing device itself, not on a control screen. Please see (page 4, lines 7-10; page 5, lines 16-45) of *Broussard*. The invention according to Broussard requires an additional intervening step before the physical device is controlled to function as desired. In contrast, claims 1 and 8 recite "a pointing device... having at least one control to control the multimedia device." Claim 16 recites "[a]pointing device...comprising at least one control to control the multimedia device." Because Broussard does not disclose all the limitations of the invention as claimed in claims 1-5, 7, 10-11, and 16-18, Broussard cannot anticipate claims 1-5, 7, 10-11, and 16-18. Therefore, Applicant respectfully requests the withdrawal of the rejection of claims 1-5, 7, 10-11, and 16-18.

Rejections Under 35 U.S.C. § 103

**Claims 7 and 9** were rejected under 35 U.S.C. § 103(a) as being unpatentable over Broussard as applied to claims 1 and 8 above, and further in view of Frank (EP 0 596 594). This combination of cited prior art teaches using a remote control device for multimedia devices using encoding and transmitting means to help facilitate selection of "target devices". Applicant respectfully objects to this combination because the Examiner has not established a *prima facie* showing of the location of the controls on the mouse in a multi-media environment. Applicant respectfully reminds the Examiner that *Broussard* discloses controlling a control panel/screen on the computer display and not a direct multi-media controller on the body of the mouse. Whereas, *Frank* does use the control device, i.e., a mouse, to control a target device ("...any remotely controlled equipment that the user wishes to integrate into the multi-media system."); nevertheless, the bottom of such a control device must be pointed at the target device associated with a target device list. Applicant's claimed invention requires no such additional dexterity and thus has the advantage of easy operation for the user. Because the combination of Broussard and Frank does not teach all of the limitations of Applicant's invention, the Examiner has failed to establish a *prima facie* case of obviousness and Applicant respectfully requests the withdrawal of the rejection of claims 7 and 9 under 35 U.S.C. 103 (a).

**Claims 12-15** were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyakawa (U.S. Patent No. 4,931,781) in view of Broussard. This combination teaches depressing a cursor movement control key switch that lowers or raises the volume for a volume

control device, e.g., speakers. Most importantly, the audio information produced relates to the cursor movement and is not independent from the cursor movement. Please see, (page 16, lines 54- 62) of *Miyakawa*. In addition, the control key switch may be used to control the brightness on the video display. The examiner argues that "Broussard teaches the usage of a mouse controller in a multi-media environment..." and mistakenly argues that "Broussard further teaches that the actuation of the buttons of the mouse would cause signals to be sent to the physical device to cause the corresponding action to occur." As stated earlier by the Applicant, Broussard does not teach anything about the actuation of buttons on a mouse. Moreover, it should be noted that the claimed device does not use a dependent cursor movement control key switch as disclosed in *Miyakawa*. Instead, Applicant's claimed invention is comprised of a group of controls including a button, a slider, and a wheel, capable of independently operating a stand-alone multi-media device.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* showing of obviousness because the Examiner has not disclosed coherently what would motivate one of ordinary skill in the art to combine the references of *Miyakawa* and Broussard. Such a combination can only yield a device that controls a cursor on a computer screen for selecting buttons on a control panel on that same computer screen, while adjusting the volume of speakers connected to that same computer. [Please see *Miyawaka*, figure 34.] Nothing vaguely in this combination will control several stand-alone multi-media devices from the body of a mouse-device or similar pointing device. The Examiner has not indicated how one of ordinary skill in the art would be motivated to invent a device that skipped a previous track on a CD-ROM drive from the combination of *Miyakawa* and Broussard that yields at best the ability to lower the volume on attached computer speakers. Applicant's claimed invention affects a wider universe of multi-media electronics (e.g. DVD, video, television, stereo equipment, etc.), whereas the cited combination narrowly and solely covers the personal computing environment. Because the combination, *Miyawaka* and Broussard, fails to teach all the limitations of Applicant's invention, the Examiner has not carried the burden of establishing a *prima facie* case of obviousness. Hence, Applicant respectfully requests the withdrawal of the rejection of claims 12-15 under 35 U.S.C. 103(a).

AMENDMENT AND RESPONSE

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**CONCLUSION**

Applicant believes the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 612-373-6944 to discuss any questions which may remain with respect to the present application.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on August 26, 1999.

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